

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MIKE KINSELLA

Appeal 2007-0150
Application 09/592,563
Technology Center 2600

Decided: February 27, 2007

Before KENNETH W. HAIRSTON, JOSEPH L. DIXON, and
HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.
HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1 to 27 and 29 to 46. We have jurisdiction under 35 U.S.C. § 6(b).

Appellant has invented a system and method for transmitting a message to an intended recipient. A database is created that has details of the appearance of individual potential recipients of messages. A received

message that has details of the intended recipient of the message is compared with the database of potential recipients of the message, and one or more possible recipients may be identified as candidates to receive the message.

Claim 1 is representative of the claims on appeal, and it reads as follows:

1. A message pushing system for sending messages to recipients, the system comprising:

a database of details of individual potential recipients; and

telecommunications links for communicating with message sending and message receiving devices, the message pushing system being adapted to receive a message from a message sending device, the message comprising details of the intended recipient of the message, wherein the message pushing system compares the details of the intended recipient of the message with the database of potential recipient's details thereby establishing one or more members who may be the intended recipient, the message pushing system being adapted to transmit said message to the message receiving means of the one or more members who may be the intended recipient.

The Examiner rejected claims 1 to 4, 9, 11, 15, 17 to 19 and 22 under 35 U.S.C. § 102(e), and the Examiner rejected claims 5 to 8, 10, 12 to 14, 16, 20, 21, 23 to 27 and 29 to 46 under 35 U.S.C. § 103(a).

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Fraccaroli

US 6,549,768

Apr. 15, 2003
(filed Aug. 24, 1999)

Appellant contends that the claimed subject matter is neither anticipated nor obvious because the matching system described by Fraccaroli does not identify an intended recipient of the message (Br. 12-18).

We sustain.

ISSUE

Does Fraccaroli identify an intended recipient of a message as required by all of the claims on appeal?

FINDINGS OF FACT

As indicated *supra*, Appellants invented a system and method for identifying an intended recipient of a message.

The Background in Fraccaroli describes a computer dating service that matches people based on a stored profile for each of the customers. A customer of the service submits a request for a match among the stored customer profiles, and the computer dating service searches the database for profiles that match the request. The database of details of potential recipients includes details of the appearance (e.g., race, height, weight, eye color, hair color) of desired recipients (Col. 1, ll. 27-33). The customer is informed of the selected matches (Col. 1, ll. 25-42). A preferred embodiment in Fraccaroli, however, describes a message pushing system that stores a database of details of individual potential recipients of a message in server 106 (Fig. 1, Col. 5, ll. 26-36). In Fraccaroli, a potential recipient can be a known person (Col. 8, ll. 44-46), a person that enters a location area (Col. 8, ll. 65-67; Col. 9, ll. 57-62; Col. 10, ll. 3-5), a close friend (Col. 9, ll. 6-9) or a person with similar interests (Col. 10, ll. 25-28). A telecommunications link (i.e., message sending and message receiving) is established between two mobile handsets 102 (Col. 3, ll. 46-55; Col. 4, ll. 64

and 65). The message pushing system is adapted to receive a message (i.e., a profile of the intended recipient) from one of the handsets 102 (Col. 8, ll. 35-66; Col. 10, ll. 52-56; Col. 11, ll. 12-16). The message pushing system compares the details of the intended recipient with the database of potential recipients, and selects one or more members as an intended recipient of the message (Col. 9, ll. 50-65). Once a matching recipient is selected, the message pushing system is adapted to (and does) transmit the message to the selected mobile message receiving handset 102 (Col. 11, ll. 12-22). The message pushing system also stores details of frequently visited locations or locations previously visited by the user of the system (Col. 10, ll. 25-28).

PRINCIPLE OF LAW

Anticipation is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

The phrase “adapted to” does not normally further limit or define a structural limitation because it is optional and it is not necessarily a required part of the structural limitation. *In re Ashley*, 315 F.2d 945, 948, 137 USPQ 361, 363 (CCPA 1963).

The details of a message are considered nonfunctional descriptive material if they are not functionally related to the message. Nonfunctional descriptive material carries no weight in the analysis of patentability over prior art applied by the Examiner. *Cf. In re Lowry*, 32 F.3d 1579, 1583, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (“Lowry does not claim merely the information content of a memory . . .”). Nonfunctional descriptive material

cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

ANALYSIS

As indicated *supra*, we disagree with Appellant's argument that the matching system described by Fraccaroli merely operates on a profile of a desired match, and does not identify "an intended recipient" of a message as set forth in all of the claims on appeal. Our description of the operation of the Fraccaroli system clearly demonstrates that all of the limitations set forth in the claims on appeal are either anticipated by or would have been obvious based upon the teachings of Fraccaroli. Although we could have ignored the functional limitations that are "adapted to" be performed, we chose not to since the Fraccaroli system is "adapted to" perform the same functions, and, as indicated *supra*, does in fact perform the noted functions. With respect to the nonfunctional descriptive material (e.g., the details of the message) in the claims on appeal, we again chose to consider it since Fraccaroli provides the details of the message to an intended recipient.

As indicated *supra*, the stored location information in Fraccaroli can be the current location of a recipient, frequently visited locations of a recipient and previous locations of a recipient.

CONCLUSION OF LAW

Anticipation has been established by the Examiner because Fraccaroli does describe an intended recipient of a message. The obviousness of the

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claimed subject matter has been demonstrated by the Examiner because Fraccaroli describes appearance as well as location information about an intended recipient.

DECISION

The anticipation rejection of claims 1 to 4, 9, 11, 15, 17 to 19 and 22 is affirmed. The obviousness rejection of claims 5 to 8, 10, 12 to 14, 16, 20, 21, 23 to 27 and 29 to 46 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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